



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/344,499 | 06/25/1999 | JOHN S. HENDRICKS | 026880.00014 | 9133 |

4372 7590 02/18/2009
ARENT FOX LLP
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

| |
|----------|
| EXAMINER |
|----------|

ABEBE, DANIEL DEMELASH

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2626

| | |
|-------------------|---------------|
| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

02/18/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com
IPMatters@arentfox.com
Patent_Mail@arentfox.com

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/344,499 | Applicant(s) HENDRICKS ET AL. | |
| | Examiner Daniel D. Abebe | Art Unit 2626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-13,22-27,29-34,43-55 and 59-62 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-13,22-27,29-34,43-55 and 59 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed on 1/9/2009 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings of figures 20-29 and 31-34 are not legible. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/8/2008 has been entered.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed applications, Application No.08/336,247, 08,160,194,08/906,469 and 08/160,281 fail to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. While the prior art applications teach different embodiments for accessing and textually displaying an electronic book, none of them disclose or provide teaching regarding the claimed invention of providing the electronic book in audio form utilizing text to speech conversion/synthesis means, which is the inventive step in the application.

Thus the applicant can not benefit priority from these applications and therefore the earlier effective date for the claimed invention is the actual filing date of the present application which is June 25, 1999.

The claimed invention incorporates text to speech synthesizers which have been well known and commercially available prior to the time of applicant's invention into the electronic book for audio presentation and will be addressed in view of prior arts in the examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8-13, 22-26, 29-34, 43-50 and 59-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quentin et al. (5,208,745) in view of Sears et al. (6,115,482).

As to claims 1 and 43, Quentin teaches a method of providing text to audio conversion of electronic text information displayed on a multimedia display (Fig.1), comprising the steps of:

Selecting a text information material for viewing from a knowledge base comprising database of textual information where the information database is remote from the multimedia unit (Fig.9; Col.4, lines 55-60; Col.23, lines 50-65);

Displaying a page of the selected information on the display where the page includes text (Fig.8);

Receiving command from the user for speech production of the text (Fig.2);

And providing the at least a portion of the text in audio form (Figs.1, 2, 5-10; Col.2, lines 25-45; Col.4, lines 8-15;).

It is noted that Quentin doesn't explicitly teach where the electronic text materials are books and the audio presentation in detail. Sears, however teaches a method for providing text to speech conversion of a text material that is displayed on a display device wherein the text material comprises electronic books, magazines, newspaper etc, comprising the steps of receiving selection of the text and synthesizing the speech (Fig.1; abstract; Col.3, lines 20-50; Col.4, lines 12-33; Col.4, line 66-Col.5, line 5; Col.6, lines 13-20).Utilizing the Quentin electronic text reading method in electronic book application would be obvious to one of ordinary skill in the art at the time of applicant's invention for the purpose of audibly presenting books for book readers in addition to the text form.

As to claims 2-3 and 45-46, Sears teaches controlling the speed and the style of the audio corresponding to text (Col.6, lines 13-20; Col.9, lines 55-65; Col.10, lines 16-30) and Quentin teaches where the user interrupts the audio presentation of the text by the multimedia through commands (Col.13, lines 50-55) therefore, pausing and resuming the audio are inherent in light of these features.

As to claims 4 and 44, Sears teaches where definitions/translations are verbally provided for words selected by the user (Col.10, lines 5-15).

As to claims 5 and 49, Sears teaches adjusting the rate of the audio output corresponding to the text and the user command (Col.9, lines 55-65).

As to claim 8, Quentin teaches a method of providing text to audio conversion of electronic text information displayed on a multimedia display (Fig.1), comprising the steps of:

Selecting a text information material for viewing from a knowledge base comprising database of textual information that is remote from the multimedia unit (Fig.9);

Receiving information related to audio function of the multimedia (Col.5, lines 8-22; Col.7, line 30-Col.8, lines37);

Displaying a page of the selected information on the display where the page includes text (Fig.8);

Receiving command from the user for speech production of the text (Fig.2);

And providing the at least a portion of the text in audio form (Figs.1, 2, 5-10; Col.2, lines 25-45). It is noted that Quentin doesn't explicitly teach where the electronic text materials are books and the audio presentation in detail. Sears, however teaches a method for providing text to speech conversion of a text material that is displayed on a display device wherein the text material comprises electronic books, magazines, newspaper etc, comprising the steps of receiving selection of the text and synthesizing the speech (Fig.1; abstract; Col.3, lines 20-50; Col.4, lines 12-33; Col.4, line 66-Col.5, line 5; Col.6, lines 13-20). The motivation for combining the two arts is same as provided for claim 1.

As to claims 9-10, Sears teaches controlling the speed and the style of the audio corresponding to text (Col.6, lines 13-20; Col.9, lines 55-65; Col.10, lines 16-30) and pausing and resuming the audio are inherent in light of these features.

As to claim 11, Quentin teaches a method of providing text to audio conversion of electronic text information displayed on a multimedia display (Fig.1), comprising the steps of:

Selecting a text information material for viewing from a knowledge base comprising database of textual information that is remote from the multimedia unit (Fig.9);

Receiving information related to audio function of the multimedia (Col.5, lines 8-22; Col.7, line 30-Col.8, lines37);

Displaying a page of the selected information on the display where the page includes text (Fig.8);

Receiving command from the user for speech production of the text (Fig.2);

And providing the at least a portion of the text in audio form (Figs.1, 2, 5-10; Col.2, lines 25-45). It is noted that Quentin doesn't explicitly teach where the electronic text materials are books and the audio presentation in detail. Sears, however teaches a method for providing text to speech conversion of a text material that is displayed on a display device wherein the text material comprises electronic books, magazines, newspaper etc and wherein the displaying comprises plurality of pages (Fig.1; abstract; Col.3, lines 20-50; Col.4, lines 12-33; Col.4, line 66-Col.5, line 5; Col.6, lines 13-20).

As to claims 12-13, Sears teaches controlling the speed and the style of the audio corresponding to text (Col.6, lines 13-20; Col.9, lines 55-65; Col.10, lines 16-30) and pausing and resuming the audio are inherent in light of these features.

With regards to Claims 22-26 and 29-34, the corresponding apparatus for performing the claimed method of providing text into audio form is analogous and therefore rejected by Quentin in view of sears.

As to claims 47-48, Quentin teaches where the displayed text includes digital video image and where the system speaks aloud text corresponding to the displayed video images and displayed text when the user requests a more detailed explanation (Fig.8; Col.21, lines 28-32). the claimed well known image formats will be inherent in Quentin system.

As to claim 50, Quentin teaches providing verbally providing command prompts (Col.16, line 60-Col.17, line 2).

As to claims 59-62, the presentation of the audio in Quentin and Sears is in real Time where the text is synthesized using audio files.

Claims 6 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quentin et al. (5,208,745) in view of Sears et al. (6,115,482) and further in view of Huffman et al. (5,663,748).

With regard to claims 6 and 27, Quentin teaches where the text to speech synthesizer enunciate unlimited pronunciation and vocabulary (Col.19, lines 55-60) however doesn't explicitly teach selecting the voice.

Art Unit: 2626

Huffman teaches a system for providing an electronic book in audio form by synthesizing speech from the text comprising a customized voice dictionary (Figs.1-6; Col.7, lines 35-45) wherein the voice dictionary comprises voice font for presenting the electronic book is selected (Fig.10; Col.7, lines 45-54). It would be obvious to one of ordinary skill in the art at the time of applicant's invention to combine the teachings for the purpose of providing the audio output in a voice of the user choice.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 51-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Huffman et al. (5,663,748).

As to claim 51, Huffman teaches a screen for use in electronically displaying a page of an electronic book on a display and permitting a user to request a text to audio function, comprising:

A section for selecting an electronic book from a remote library;

A section for displaying a page of the book;

A section for allowing the user to request conversion of the text into speech (Figs. 5-24).

As to claims 52-55, Huffman teaches providing the user with screen interface to control the multiple function of the electronic book reader (Fig.25)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fernandez (4,855,725) "microprocessor based simulated book"

"A system includes a personal computer (10) and a simulated book (30). A mass storage device, such as a compact disk (CD) read only memory (ROM) (22), is connected to the personal computer, and the computer and the simulated book are connected by an infrared (IR) data communications link including IR transceivers (26, 48). The simulated book includes a display screen (34) and a microprocessor (43) with memory (44, 46). The microprocessor is programmed for storing data received and decoded by its IR transceiver (48) in memory (46) and responsive to user input for displaying a page of data on the display screen. In addition, the microprocessor is programmed to cause its IR transceiver (48 I) to transmit to the IR transceiver (26) connected to the personal computer (10) a data request command, and the personal computer is in turn programmed to transmit data from the CD ROM (22) to the simulated book (30). Data can be loaded in the simulated book and accessed at a later time when out of the proximity of the personal computer" (abstract)

Haynes (4,302,193) "reading tutor"

"An audio-visual educational aid which coordinates reading of textual material with an audio presentation of the material. An audio reproduction of the material is made on a recording medium together with audio player control signals."

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel D. Abebe whose telephone number is 571-272-7615. The examiner can normally be reached on monday-friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel D Abebe/
Primary Examiner, Art Unit 2626

Application/Control Number: 09/344,499
Art Unit: 2626

Page 12